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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,533	11/08/2001	James Clough	10015195-1	2570

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

RUHL, DENNIS WILLIAM

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/007,533

Applicant(s)

CLOUGH ET AL.

Examiner

Dennis Ruhl

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-4, 6-14, 16-22, 25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-4, 6-14, 16-22, 25 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Applicant's response of 2/1/05 has been entered and the examiner will address applicant's remarks at the end of this office action. Applicant should take notice that claim 18 (and dependent claims) have been interpreted in two manners and the 103 rejection for these claims has been done only to aid applicant in an understanding of the closest prior art.

1. The amendment filed 2/1/05 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The language defining that the request for a search is done in response to a software application attempting to perform a print operation (cl 13) or as part of the print operation, sending a search request (cl. 18). The specification as originally filed did not disclose anything about the search being initiated in response to an attempt to print or as part of a printing operation. Page 6 states "The procedure begins when a user executes a facility selection application (block 202). The user provides various information...". Applicant stated that page 5 provides support for this language but the examiner can find no such disclosure on page 5 relating to a printing operation.

Applicant is required to cancel the new matter in the reply to this Office Action.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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3. Claims 2-4,6-14,16-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims are rejected for the same reasons as set forth in the objection to the amendment for the reasons of new matter. Claims 13 and 18 have been amended to contain new matter that was not disclosed in the application as originally filed.

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 18-21,2-4,6-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim is reciting a storage medium and has a scope that allows for the storage medium to be a signal in transmission that contains instructions to perform a method. The claims are not limited to a physical structure and can be intangible like a transmitted signal. Signals are not statutory subject matter and if a claim reads on statutory subject matter and non-statutory subject matter, the claim is to be rejected as being non-statutory.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 13,14,16,17, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claim 13, the scope of the language "in response to a software application attempting to perform a print operation" is not clear. Is this language part of the claim as far as actual steps go? The step of initiating a request for a search is in response to at attempt to perform a printing operation, but is the actual step of attempting a printing operation positively claimed and part of the claimed method? This is not clear and for purposes of examination the examiner has not taken this recitation as a positive step of the method. What is the scope of a "printing operation"? Can this be the resizing of the font for a document that is to be printed or can this be the user specifying a portrait or landscape format for the printing under the options menu? Another reasons the examiner feels the claim is indefinite is that if the situation arises where the printing operation is successful, what does the claim require? The steps of initiating a request for a search, etc. are only present if at attempt is made, but what if the an actual printing operation is conducted? What then does the claim require as far as a method goes? The scope of this claim is indefinite.

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 18-21, 2-4, 6-12 are rejected under 35 U.S.C. 102(b) as being anticipated by a storage medium such as the notoriously well known and very old devices such as a floppy disk, a compact disk (cd), or a computer hard drive. These are all computer readable medium that were in existence many years prior to the filing date of the instant application. The language "for providing computer executable instructions" to perform the recited method is simply a recitation of the intended use of the computer readable medium and is not a recitation that the medium is actually storing the instructions. Claim 18 has a scope that is only claiming a computer readable medium (a hard drive or storage disk). All of the recitations directed to the method are set forth as the intended use of the computer readable medium and are not required to reject the claim. Any floppy disk, cd, or hard drive is fully capable of providing instructions as claimed if the instructions are stored on the medium (which has not been claimed).

10. Claims 22, 25, 26, are rejected under 35 U.S.C. 102(b) as being anticipated by Schneider et al. (5832452).

For claim 22, Schneider discloses a system for assisting a user in locating a facility that satisfies certain user-defined criteria. The system has a storage device 13 that stores facility information and a processor 11. The recitation that the stored information is "printing services" is non-functional descriptive material and is satisfied by Schneider. The type of data being stored is taken as non-functional descriptive material. The storage device of Schneider is configured as claimed (is capable of

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storing the claimed information) and the processor operates as claimed. With respect to the recitation of the processor being configured to execute instructions for making a reservation, this is satisfied by the processor having the feature of allowing for the printing of a reservation form. The claimed generation of a report by the processor is taken to be the saving of data to a data file as disclosed in column 5, lines 48-49. The content of the report is non-functional descriptive material and does not serve as a limitation. A report is very broad language and can be almost anything. The processor of Schneider is fully capable of everything that is claimed.

For claims 25, the claim is reciting the type of computer related service that can be searched for, which is non-functional descriptive material. The device of Schneider is fully capable of storing the claimed type of information.

For claim 26, when the user enters desired criteria for the search, by conducting the search and finding results, the processor has found a facility with a compatible service to whatever the search criteria set forth. The recitation that the type of service is a printing service is non-functional descriptive material and does not serve as a limitation.

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims '2-4,6-14,16-21, are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneider et al. (5832452).

For claims 13,16,18-20,2-4,6,9, Schneider discloses a system and method for assisting a customer in finding a lodging facility. Schneider discloses that a customer can submit a request to locate a lodging facility that will offer particular services. A computer system contains hotel information and uses customer entered criteria to perform a search for a lodging facility that satisfies the entered user defined criteria, and displays the resulting list. See column 2, lines 55-58; column 3, lines 46-48; column 3, line 67 to column 4, line 13; column 4, lines 25-34 and column 4, lines 36-39.

Schneider discloses that the criteria that the system uses to perform the search can be those disclosed in column 3, line 67 to column 4, line 2. Schneider does not specifically disclose that the customer can perform a search for facilities that offer a certain computer related service such as a printer. Schneider discloses that the amenities that a particular hotel offers, such as whether or not there is a fax machine in the room, are

displayed to the customer and are stored in an amenity file. See column 5, lines 30-35. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the system of Schneider allow a user to also search for the type of amenities a hotel offers. This would include looking for a facility that has a fax machine in the room. Schneider recognizes various search categories that are able to be searched, and it would have been obvious to have one category be the amenities offered, such as a fax machine (a computer related service and also a printer).

For claim 18, in addition to what the examiner has set forth in the preceding paragraph, the "receiving a request to print a selected item" is satisfied by the user printing a reservation request form. The claimed "print operation" is taken as broad language and the method of Schneider (searching for a hotel, and printing a reservation form) are all part of an operation to locate a facility.

For claim 14, it necessarily follows that a person who is searching for a particular computer related service (printer) in a hotel would figure out if the printer is compatible with their computer system. This is why the user is searching in the first place, so they can locate a particular service that they desire.

For claims 7,8, not disclosed is that the computer related service is a printer at the front desk of the facility or in a conference room. The above 103 combination results in the user being able to search for the amenities that a hotel offers, such as if there is a fax machine in the room and the examiner considers it obvious to one of ordinary skill in the art at the time the invention was made to allow the user to search for amenities such as whether or not there is a printer at the front desk. The type of

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amenity being searched for will not be sufficient to patentably distinguish over the prior art.

For claims 6,16, Schneider discloses what is claimed because a fax machine has a printer. A fax machine is also a printer.

For claims 10,17, Schneider discloses the printing of a reservation form so the customer can make a reservation once a satisfactory facility is located. The printing of the form is an initiation of a reservation as claimed.

For claims 11,12, not disclosed is the generation of a report that identifies how many reservations are made by using the claimed method. This is basic analysis of how effective a marketing tool is. It would have been obvious to one of ordinary skill in the art at the time the invention was made to generate a report of some kind that shows whether or not the marketing of the hotel in the system of Schneider is worthwhile. Clearly one would want to know how effective the system of Schneider is so that one's marketing campaign for the hotel is as successful as possible. If no reservations are ever made by the use of the system of Schneider it may not be worthwhile to continue with the use of the system.

For claim 21, not disclosed is that the facility is for an airport. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the system of Schneider for airports. Schneider allows one to search for a facility using search criteria, so the use of the method of Schneider for any type of facility, whether it be for restaurants or airports, or for health spas is considered obvious.

14. Applicant's arguments filed 2-1-05 have been fully considered but they are not persuasive.

With respect to the 102 rejection in view of Schneider, the argument presented is that the prior art does not teach a system that can search for a printing service as the search criteria and the prior art cannot generate a report of reservations. In the pending article claims (not method claims) the type of service being searched for and the content of the report are considered to be non-functional descriptive material that does not serve to distinguish over the prior art. The prior art discloses the searching of a database for user defined criteria to assist in locating a lodging facility. The type of criteria being searched is not a patentably distinguishing feature. The content of the report is printed matter that also is not a patentably distinguishing feature.

With respect to the 103 rejection, the entire argument is based on new matter that was never disclosed in the application as originally filed. The examiner requests that applicant either cancel the new matter or provide and discuss the specific portions of the specification that allegedly provide support for the amended language. Page 5 does not provide support for what is claimed. The second paragraph of arguments on page 9 is interesting in that this was not the original intent of the invention as originally filed. The originally disclosed invention was for a person to locate a facility that they may travel to, not for a person to locate a facility to print a document when they have no printer available. Why would a person wishing to print a document want to know that the airport in Denver can print it for them, when they are in NY? The argument that the

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search in performed in response to a print operation is new matter and is a non-persuasive argument.

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DENNIS RUHL
PRIMARY EXAMINER